

**Amendment and Response under 37 C.F.R. 1.116**

Applicant: Robert Sesek

Serial No.: 09/887,833

Filed: June 21, 2001

Docket No.: 10006174-1 (H303.202.101)

Title: ELECTRONIC DOCUMENT SENDER SYSTEM AND METHOD WITH EXTERNAL ADDRESS ACCESS

**REMARKS**

The following remarks are made in response to the Final Office Action mailed January 11, 2006. Claims 1, 3-7, 9-15, 18, 19, and 23-25 were rejected. With this Response, claims 1, 6-7, 10-12, 14-15, 19, and 23 have been amended and claims 2, 8, 16-17, 20-22, and 24 are canceled. Claims 1, 3-7, 9-15, 18-19, 23, and 25 remain pending in the application and are presented for reconsideration and allowance.

**Response to Declaration Under 37 C.F.R. 1.131**

In the Office Action, the Declaration under 37 C.F.R. 1.131 was considered ineffective to overcome the effective filing date of Rhoads U.S. Patent Publication 2002/0142765 (herein the Rhoads Publication) and/or Besprosvan U.S. Patent Publication 2002/0124057 (the Besprosvan Publication).

First, Applicant agrees with the position taken in the Office Action that Exhibit A establishes conception.

Second, in the Office Action, it was asserted that no explanation is given for lack of diligence in the two and a half month period between the conception (August 2000) and the Engagement Agreement (October 2000). However, as also noted in the Office Action, under 37 C.F.R. 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference (or activity) and ends with the date of reduction to practice, either actual or constructive. Accordingly, the assertion regarding this two and one-half month period is misplaced for asserting lack of diligence as Applicant need not prove diligence from the time of conception (e.g., August 2000) to the point in time just prior (e.g. early March 2001) to the effective date of the reference (March 5, 2001 and/or March 30, 2001). Consequently, Applicant need not prove diligence between August 2000 and October 17, 2000 in order to establish diligence under 37 C.F.R. 1.131.

For these reasons, Applicant respectfully requests that this assertion regarding lack of diligence regarding the time period of August to October 2000 be withdrawn.

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Third, in the Office Action, it was asserted that in light of statements made on Exhibit A, "the declaration is ineffective to overcome the effective filing date of the Rhoads Publication or the Besprosvan Publication for at least these reasons. Applicant contests this assertion, as Exhibit A was presented not to prove an actual reduction to practice, but to establish conception. Later in the Office Action, it was accepted that Exhibit A does establish conception. Accordingly, Applicant respectfully requests withdrawal of the broad assertion that the declaration is ineffective "for at least these reasons", as one cannot make a dispositive conclusion regarding the adequacy of the Declaration based on a single exhibit, Exhibit A, that was confirmed as establishing conception.

Fourth, it was asserted in the Office Action that "no explanation was given for the 4 week period between the completed application and the filing thereof". Applicant respectfully submits that this period of time in June 2001 was necessarily used to obtain the signature of the inventor on the declaration of the patent application and coordinate the filing of the patent application within the internal administration of Applicant's patent counsel after their receipt of the completed text and drawings of the patent application (and blank signature papers) from the outside counsel, Steven Dicke.

Accordingly, the preparation of the patent application proceeded steadily from early March 2001 (prior to the effective date of the references) through late May 2001, concluding with the filing of the patent application in June 2001. Applicant submits that this timeline of events including activity in each of the months of March, April, May, and June directed toward preparation, execution, and filing of the patent application demonstrates reasonable diligence in preparing and filing the patent application.

For these reasons, among the other facts established in the Declarations and their accompanying Exhibits, Applicant respectfully requests submits that the Declarations demonstrate conception and reasonable diligence and therefore respectfully requests withdrawal of the rejection of claims 1, 2-7, 9-10, 11-15, 18, 19, and 23-25 under 35 U.S.C §102 and §103 based on the Rhoads Publication and/or the Besprosvan Publication

**Claim Rejections under 35 U.S.C. § 102**

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In the Office Action, claims 1, 2-7, 9-10, 12-13, 15, 18, 19, and 23-25 were rejected under 35 U.S.C. § 102(e) as being anticipated by the Rhoads Publication.

Applicant's amended independent claim 1 specifies a method of electronic document sending. The method comprises electronically obtaining the electronic address of the electronic document receiver, via wireless communication, from an address book located externally of the electronic document sender in a mobile computing device that is separate from the electronic document sender. The electronic address of the electronic document receiver is stored in an internal address book of the electronic document sender. The electronic address of the electronic document receiver is retrieved from the internal address book of the electronic document sender and an electronic document is sent from the electronic document sender to the electronic document receiver using the retrieved electronic address.

The Rhoads Publication is directed to programming the configuration information (e.g., an IP address) of a network appliance using a wireless device to transmit signals to a wireless interface of the network appliance wherein the signals from the wireless device are used to configure the network appliance. Rhoads Publication at paragraph 0016, 0028.

Accordingly, the IP address transmitted by the wireless device in the Rhoads Publication is not an electronic address of a third device, such as an electronic document receiver, that is separate from a mobile computing device and an electronic document sender, as claimed by Applicant. Unlike the system in the Rhoads Publication, the method in Applicant's claim 1 is not about configuring an electronic document sender, but instead makes available to the electronic document sender an electronic address of a third device — the electronic document receiver— for sending an electronic document to the third device.

Moreover, the Rhoads Publication fails to disclose an internal address book of an electronic document sender to which the electronic address of the electronic document receiver is stored, as recited in Applicant's claim 1. In addition, the Rhoads Publication fails to disclose sending from the electronic document sender an electronic document using the retrieved electronic address of the electronic document receiver, as claimed by Applicant.

Finally, the assertion in the Office Action regarding "well known" functions of a facsimile machine that sends an electronic document does not address the above-detailed deficiencies of the Rhoads Publication.

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For these reasons, the Rhoads Publication fails to teach or suggest Applicant's independent claim 1. Accordingly, Applicant's believe that independent claim 1 is allowable over the Rhoads Publication. Moreover, claims 3-6 are believed to be allowable based on their dependency from patentably distinct independent claim 1.

Applicant's independent claim 7 is directed to a method of document sending.

The Rhoads Publication is directed to programming the configuration information (e.g., an IP address) of a network appliance using a wireless device to transmit signals to a wireless interface of the network appliance wherein the signals from the wireless device are used to configure the network appliance. Rhoads Publication at paragraph 0016, 0028.

However, the IP address transmitted by the wireless device in the Rhoads Publication is not an electronic address of a third device, such as an electronic document receiver, that is independent from a mobile computing device and an electronic document sender, as claimed by Applicant. Unlike the system in the Rhoads Publication, the method in Applicant's claim 7 is not about configuring an electronic document sender, but instead importing to the electronic document sender an electronic address of a third device -- the electronic document receiver -- for sending an electronic document to the third device. In other words, in Applicant's claimed method of claim 7, the imported electronic address is not the electronic address of the device to which the electronic address is imported, as occurs in the Rhoads Publication.

In addition, the Rhoads Publication fails to disclose sending from the electronic document sender an electronic document using the imported electronic address of the electronic document receiver, as claimed by Applicant.

Finally, the assertion in the Office Action regarding "well known" functions of a facsimile machine that sends an electronic document does not address the above-detailed deficiencies of the Rhoads Publication.

For these reasons, the Rhoads Publication fails to teach or suggest Applicant's independent claim 7. Accordingly, Applicant's believe that independent claim 7 is allowable over the Rhoads Publication. Moreover, claims 9-11 are believed to be allowable based on their dependency from patentably distinct independent claim 1.

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For substantially the same reasons as presented for patentability of claim 1, the Rhoads Publication fails to disclose Applicant's amended independent claim 23 which is directed to a computer readable medium having computer-executable instructions for performing a method of document sending -- the method including substantially the same limitations as claim 7. For these reasons, the Rhoads Publication fails to teach or suggest amended independent claim 23, and therefore Applicant's amended independent claim 23 is patentable and allowable over the Rhoads Publication. Claim 25 is believed to be allowable based on its dependency from independent claim 23.

Applicant's amended independent claim 12 specifies an electronic document sender.

The Rhoads Publication is directed to programming the configuration information (e.g., an IP address) of a network appliance using a wireless device to transmit signals to a wireless interface of the network appliance wherein the signals from the wireless device are used to configure the network appliance. Rhoads Publication at paragraph 0016, 0028.

However, the IP address transmitted by the wireless device in the Rhoads Publication is not an electronic address of a third device, such as an electronic document receiver, that is independent from a mobile computing device and an electronic document sender, as claimed by Applicant. Unlike the system in the Rhoads Publication, the device in Applicant's claim 12 does not configure a network appliance with an IP address of the network appliance, but instead includes an electronic document sender including a communication module configured for wirelessly obtaining the electronic address of the electronic document receiver.

In addition, the Rhoads Publication fails to disclose a communication module an electronic document sender configured for sending (from the electronic document sender) an electronic document to the electronic address of the electronic document receiver (obtained from the separate mobile computing device), as claimed by Applicant.

Finally, the assertion in the Office Action regarding "well known" functions of a facsimile machine that sends an electronic document does not address the above-detailed deficiencies of the Rhoads Publication.

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For these reasons, the Rhoads Publication fails to teach or suggest Applicant's independent claim 12. Accordingly, Applicant's believe that independent claim 12 is allowable over the Rhoads Publication. Moreover, claims 13-14 are believed to be allowable based on their dependency from patentably distinct independent claim 1.

Applicant's independent claim 15 specifies an electronic document sending system.

The Rhoads Publication is directed to programming the configuration information (e.g., an IP address) of a network appliance using a wireless device to transmit signals to a wireless interface of the network appliance wherein the signals from the wireless device are used to configure the network appliance. Rhoads Publication at paragraph 0016, 0028.

However, the IP address transmitted by the wireless device in the Rhoads Publication is not an electronic address of a third device, such as an electronic document receiver, that is independent from a mobile computing device and an electronic document sender, as claimed by Applicant. Unlike the system in the Rhoads Publication, the system in Applicant's claim 15 does not configure a network appliance with an IP address of the network appliance, but instead includes an electronic document sender configured for obtaining, via electronic wireless communication, the first electronic address of the electronic document receiver from the address book of the mobile computing device, wherein the electronic document sender has a second electronic address different than the first electronic address of the electronic document receiver.

In addition, the Rhoads Publication fails to disclose an electronic document sender configured for sending (from the electronic document sender) an electronic document to the electronic address of the electronic document receiver (obtained from the separate mobile computing device), as claimed by Applicant.

Finally, the assertion in the Office Action regarding "well known" functions of a facsimile machine that sends an electronic document does not address the above-detailed deficiencies of the Rhoads Publication.

For these reasons, the Rhoads Publication fails to teach or suggest Applicant's independent claim 15. Accordingly, Applicant's believe that independent claim 15 is allowable over the Rhoads Publication. Moreover, claims 18-19 are believed to be allowable based on their dependency from patentably distinct independent claim 15.

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In light of the above, Applicants respectfully request withdrawal of the rejection of claims 1, 2-7, 9-10, 12-13, 15, 18, 19, and 23-25 based on the Rhoads Publication under 35 U.S.C. §102.

**Claim Rejections under 35 U.S.C. § 103**

In the Office Action, claim 11 was rejected under 35 U.S.C. 103(a) as unpatentable over the Rhoads Publication in view of Hattori U.S. Patent 6,512,599 (the Hattori Patent).

Claim 11 is believed to be allowable based on its dependency from amended independent claim 7, which is believed to be allowable for the reasons previously presented in favor of the patentability of claim 7. In addition, the Hattori Patent fails to cure the deficiencies of the Rhoads Publication regarding amended independent claim 7 as the Hattori Patent is directed generally to a facsimile transmission system and its operation rather than a method including wirelessly importing from a mobile computing device into an electronic document sender an electronic address of an electronic document receiver, as claimed by Applicant. Accordingly, one cannot combine the Rhoads Publication and the Hattori Patent to arrive at Applicant's claim 11.

In the Office Action, claim 14 was rejected under 35 U.S.C. 103(a) as unpatentable over the Rhoads Publication in view of the Besprosvan Publication.

Claim 14 is believed to be allowable based on its dependency from amended independent claim 12, which is believed to be allowable for the reasons previously presented in favor of the patentability of claim 12. In addition, the Besprosvan Publication fails to cure the deficiencies of the Rhoads Publication regarding amended independent claim 12 as the Besprosvan Publication is directed to a server based system for aggregating at a single location information from different sources rather than: (1) an electronic document sender including a communication module configured for wirelessly obtaining (from a mobile computing device) the electronic address of the electronic document receiver, as claimed by Applicant; and (2) a communication module configured for sending the electronic document from the electronic document sender to

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the electronic address of the electronic document receiver. Accordingly, one cannot combine the Rhoads Publication and the Besprosvan Publication to arrive at Applicant's claim 14.

In light of the above, Applicants respectfully request withdrawal of the rejection of claims 11 and 14 based on the Rhoads Publication, the Hattori Patent, and/or the Besprosvan Publication under 35 U.S.C. §103.

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**CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 1, 3-7, 9-15, 18-19, 23 and 25 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1, 3-7, 9-15, 18, 19, 23, and 25 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(h)(i). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Jeff Limon at Telephone No. 541-715-5979, Facsimile No. 541-715-8581 or Paul S. Grunzweig at Telephone No. 612-767-2504, Facsimile No. 612-573-2005. In addition, all correspondence should continue to be directed to the following address:

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Intellectual Property Administration  
P.O. Box 272400  
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Respectfully submitted,

Robert Sese,

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**CERTIFICATE UNDER 37 C.F.R. 1.8:** The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 13 day of Mar, 2006.

By Paul S. Grunzweig  
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